REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed September 15, 2008, Advisory Action mailed January 12, 2009, and Notice of Panel Decision from Pre-Appeal Brief Review mailed March 13, 2009. At the time of the Notice of Panel Decision, Claims 9-16 stood rejected in this Application. Claim 9 is herein amended to incorporate the limitations of dependent Claim 14, and Claim 14 is cancelled without prejudice or disclaimer. Applicant respectfully requests reconsideration and favorable action in this case.

Rejections under 35 U.S.C. §103

Claims 9-16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over PCT Publication 98/30053 filed by Holmstrom *et al.* ("*Holmstrom*") in view of U.S. Patent No. 6,009,338 issued to Yuji Iwata *et al.* ("*Iwata*"). Although Applicant does not agree with the Examiner's position rejection -- in particular, his position that *Iwata* teaches "at least one database stored in the nonvolatile memory and, *each of the at least one database being respectively assigned to precisely one of the at least one electronic telephone directory*" (as Applicant explained in its Pre-Appeal Brief), Applicant has amended the claims in order to further clarify the distinction with the cited references.

For example, Applicant has amended independent Claim 9 to include the limitations of dependent Claim 14, such that amended Claim 9 recites, in part:

> at least one electronic telephone directory . . .
>
> at least one database . . ., each of the at least one database being respectively assigned to precisely one of the at least one electronic telephone directory, each database including multiple database entries;
>
> wherein each entry of a telephone directory is assigned to a corresponding database entry having a data field of variable size with respect to a number of additional attributes assigned to the telephone directory entry; and
>
> wherein the data field of a database entry contains the additional attributes of the telephone number of the corresponding telephone directory.

Holstrom and *Iwata*, separately or as combined by the Examiner, fail to teach or suggest these elements. The Examiner acknowledges that *Holstrom* does not teach or suggest at least the two "wherein" limitations recited above. However, the Examiner argues that *Iwata* does teach these limitations.

For example, regarding Claim 9, the Examiner argues that:

> . . . Iwata teaches a mobile phone (See fig. 1) comprising an electronic telephone directory wherein each entry of the telephone directory (e.g. MATSUURA JIRO) being assigned to precisely a corresponding expansion telephone directory entry having a data field of variable size with respect to a number of additional attributes assigned to the telephone directory entry (e.g. home address, office address, company's name, a home fax number, office fax number) (See figs. 6-7 and col. 14 line 4 to col. 15 line 13).

> (Final Office Action, page 3)

Regarding dependent Claim 14 (now incorporated into Claim 9), the Examiner argues:

> Iwata further discloses each of the database entries includes a characteristic diagram which points to the corresponding telephone directory entry in the corresponding telephone directory, wherein the characteristic diagram of the database entry contains the corresponding telephone number in the data field of the database entry contains the additional attributes of the telephone number of the corresponding telephone directory (See fig. 7 and col. 14 line 64 to col. 15 line 13).

> (Final Office Action, pages 3-4)

Applicant submits that these passages of *Iwata* simply does not teach a telephone directory and a corresponding database, in which each entry of the telephone directory is assigned to a corresponding database entry having a variable size data field that contains additional attributes of the telephone number of the corresponding telephone directory entry. In fact, *Iwata* does not even teach a separate telephone directory and corresponding database, but instead teaches a single "address book" that includes all of the data that the Examiner attempts to equate with telephone directory entries and corresponding database entries, as discussed below.

The relevant portions of *Iwata*, col. 14 line 4 to col. 15 line 13 teach:

> FIG. 6 is a drawing showing a screen example displaying **a name list of the ADDRESS BOOK**. FIG. 7 is a drawing showing a screen example of displaying a **detailed information of the ADDRESS BOOK**. . . .

> FIG. 6 is explained first.

> . . . For the example of FIG. 6, **a name list of the ADDRESS BOOK is displayed, and the user selects MATSUURA JIRO among them**.

> . . .

> Menu area 30 displays the functional level menu. When a desired function is touched and selected from the menu, the function is activated and data is displayed on content area 27. For the example shown in FIG. 6, the name data of Japanese Kanji characters and Roman characters displayed in content area 27 is obtained by selecting the ADDRESS BOOK in menu area 30. . . .

> FIG. 7 is explained next.

> As shown in FIG. 6, in the state in which the name list of the ADDRESS BOOK is displayed in content area 27, if MATSUURA JIRO displayed in content area 27 is double touched, or MATSUURA JIRO displayed in content area 27 is touched, and then the DETAILS displayed in menu area 30 is touched, content area 27 displays the screen of DETAILS of the ADDRESS BOOK as in FIG. 7. And in content area 27, HOME ADDRESS, HOME PHONE, HOME FAX, COMPANY NAME, DEPT. POSITION, OFFICE ADDRESS, OFFICE PHONE, OFFICE FAX, and etc., corresponding to the name MATSUURA JIRO are displayed. If HOME PHONE is double touched, for instance, the telephone function, which will be explained later is activated, and after the S button is touched, a telephone call can be made. At this stage, if the NAME LIST displayed in menu area 30 is touched, the status (the screen) shown in FIG. 6 can be recovered.

Thus, Figures 6 and 7 are simply two displays of different data from a single ADDRESS BOOK. Figure 6 shows a list of names taken from the ADDRESS BOOK, and Figure 7 shows detailed information taken from the same ADDRESS BOOK. When the name list from the ADDRESS BOOK is displayed on the phone (Figure 6), the user may double touch a name (e.g., MATSUURA JIRO), causing the phone to retrieve and display additional information from the ADDRESS BOOK (Figure 7).

In other words, in *Iwata*'s system, <u>all of the data</u> for each entry (e.g., MATSUURA JIRO entry) is <u>stored together in the ADDRESS BOOK,</u> rather than in a telephone directory storing some data and a corresponding database storing addition data, as recited in Applicant's claims. Thus, *Iwata* actually teaches away from Applicant's invention. Further, because *Iwata* does not teach a telephone directory storing some data and a corresponding database storing addition data, *Iwata* cannot not teach a database entry assigned to a corresponding telephone directory, much less where the database entry includes a variable size data field that contains additional attributes regarding the corresponding telephone directory entry.

For example, with regards to the MATSUURA JIRO entry, all data regarding that entry -- both the name "MATSUURA JIRO" displayed in Figure 6 and the additional details displayed in Figure 7 -- is stored together in the ADDRESS BOOK. *Itawa* simply does not teach a <u>database entry</u> that contains the data displayed in Figure 7 that is assigned to a <u>corresponding telephone directory</u>. The fact that *Itawa* may store data similar to that which may be stored in a database entry and corresponding telephone directory is not sufficient. The claimed invention relates not to the type of data being stored, but to <u>the manner in which the data is stored and linked together</u> -- specifically, in telephone directory entries including a relatively small amount of data, and corresponding database entries including additional related data. This allows telephone directory entries that may be limited in size to be conveniently linked to a database entries that may have a variable size for data that may not be stored in the telephone directory (due to size or field limitations). As discussed above, *Itawa* stores all of this data together in a single ADDRESS BOOK, and thus cannot be related to the claimed invention.

Therefore, Applicant submits that the recited invention is significantly different than *Itawa*. If the Examiner still believes that *Iwata* teaches both a telephone directory and a separate corresponding database having entries containing additional attributes regarding the individual telephone directory entries, Applicant requests that the Examiner indicate specifically which elements in *Itawa* can be equated with (a) the telephone directory and (b) the corresponding database, keeping in mind that the ADDRESS BOOK cannot be equated with *both* of these claimed features.

For at least these reasons, Applicant respectfully submits that amended Claim 9 is allowable over the proposed *Holstrom-Iwata* combination. Therefore, Applicant respectfully requests reconsideration and allowance of amended Claim 9 and all claims that depend therefrom.

Request for Continued Examination

Applicant respectfully submits a Request for Continued Examination (RCE) Transmittal. The Commissioner is authorized to charge any fees required to Deposit Account 50-4871 in order to effectuate these filings.

Association of Customer Number and Change of Correspondence Address

Applicant respectfully requests that all papers pertaining to the above-captioned patent application be associated with Customer No. **86528,** and direct all correspondence pertaining to this patent application to practitioners at Customer Number **86528.** All telephone calls should be directed to Eric M. Grabski at 512.457.2030. A Revocation and Power of Attorney will be filed shortly.

CONCLUSION

     Applicant has made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicant respectfully requests reconsideration of the pending claims.

     Applicant encloses a Request for Continued Examination (RCE) and authorize the Commissioner to charge $810.00 (RCE fee) to Deposit Account No. 50-4871 of King & Spalding LLP.

     Applicant respectfully submits a Petition for Three-Month Extension of Time. The Commissioner is authorized to charge the fee of $1110.00 required to Deposit Account 50-4871 of King & Spalding LLP in order to effectuate this filing.

     Applicant believes there are no additional fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-4871 of King & Spalding L.L.P.

     If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.457.2030.

Respectfully submitted,
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Date: July 15, 2009

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